

Applicant : Donald K. NEWELL, et al.  
Serial No. : 09/474,783  
Filed : December 30, 1999  
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### **REMARKS**

Claims 1 through 21 are pending in this application. Claims 1, 7 and 19 are the independent claims.

The Examiner has rejected claims 1 through 6 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner has rejected claims 1 through 7 and 10 through 20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,619,247 to Russo. The Examiner has rejected claims 9 and 21 under 35 U.S.C. 103(a) as being unpatentable over Russo. The Examiner has rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Russo in further view of U.S. Patent No. 4,945,563 to Horton, et al. Claims 1, 5 and 6 have been amended to overcome the Section 112, second paragraph, rejection. Claims 1, 7 and 19 have been amended to bring out a feature of the present invention and to put the claims in better form and no new matter has been added.

### **REJECTIONS UNDER 35 U.S.C. § 112**

The Examiner has rejected claims 1 through 6 under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1, 5 and 6 have been amended to remove the references to "apparatus" to overcome the rejection. Therefore, the § 112, second paragraph, rejection is now believed to be moot and withdrawal of the rejection is respectfully requested.

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**REJECTIONS UNDER 35 U.S.C. § 102**

The Examiner has rejected claims 1 through 7 and 10 through 20 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,619,247 to Russo. Claims 1, 7, and 19 have been amended to overcome the rejection.

Claim 1 has been amended to recite: "A system comprising a receiver in communication with a source of broadcast content and coupled to a playback device, the receiver to control the use of received broadcast content through the playback device in accordance with control information embedded in the broadcast content, said embedded control information defining an action to be taken pertaining to said broadcast content."

Russo discloses a subscriber's stored program pay-per-play system having high capacity storage to record and playback programs. In the Russo system "several types of supplemental information are possible, including future schedule memory information, . . . authorization keys and information relating to compression algorithms . . ." column 8, lines 58 through 64.) However, this supplemental information is only used to enable the use of the program information as already specified and/or enabled by the provider of the program information. (See column 4, lines 50 through 64 and column 6, lines 9 through 24.) In contrast, claim 1 recites that the embedded control information actually defines an action to be taken pertaining to said broadcast content. (See specification page 8, lines 11 through 21.) Therefore, nothing in Russo discloses or suggests sending control information embedded in the broadcast content where the "embedded control information

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defin[es] an action to be taken pertaining to said broadcast content," as recited in claim 1. Accordingly, the section 102 rejection of claim 1, and claims 2 through 6 that depend therefrom, is believed to be overcome.

Regarding claims 7 and 19, they have each been amended similar to claim 1, and now both recite, *inter alia*,: "... , said extracted control information defining an action to be taken pertaining to said broadcast content." Therefore, for at least those reasons given above for claim 1 the Section 102 rejection of claims 7 and 19, and the claims that depend variously therefrom, is believed to be overcome.

Accordingly, Applicant respectfully requests the Examiner issue a notice of allowance of claims 1 through 7 and 10 through 20.

#### **REJECTIONS UNDER 35 U.S.C. § 103**

The Examiner has rejected claims 9 and 21 under 35 U.S.C. 103(a) as being unpatentable over Russo. The rejection is respectfully traversed.

The Examiner has rejected claim 8 under 35 U.S.C. 103(a) as being unpatentable over Russo in further view of U.S. Patent No. 4,945,563 to Horton, et al. The rejection is also respectfully traversed.

For at least those reasons stated above for claims 1 through 7, and 10 through 20, the Section 103 rejections of claims 8, 9 and 21 are believed to be overcome. Accordingly,

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claims 8, 9 and 21 are believed to be allowable and a notice to that effect is respectfully requested.

### CONCLUSION

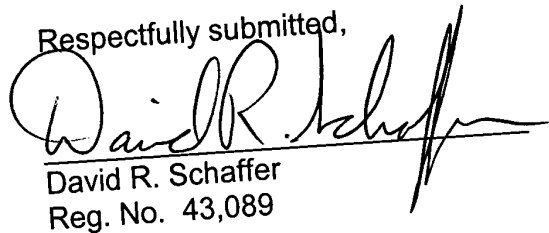
In view of the above amendments and remarks, the Applicants respectfully submit that the present case is in condition for allowance and request that the Examiner issue a notice of allowance to that effect.

The Office is hereby authorized to charge any fee deemed necessary under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayment to Kenyon & Kenyon **Deposit Account No. 11-0600**.

The Examiner is invited to contact the undersigned at (202) 220-4263 to discuss any matter concerning this application.

Dated: April 14, 2003

Respectfully submitted,

  
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